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10/693,815	10/24/2003	Gene DiPoto	ENDIUS.031A	1092

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CROMPTON, SEAGER & TUFTE, LLC  
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MINNEAPOLIS, MN 55403-2420

EXAMINER
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RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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01/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/693,815

Applicant(s)

DIPOTO, GENE

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 18, 23-28, 32, 33, 35 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 19-22, 29-31, 34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/26/07</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 26, 2007 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 26 and 47 of U.S. Patent No. 6,800,084 in view of Zucherman et al. (US 6,074,390).

Patented claims 2, 26 and 47 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 9, 17 and 25 of U.S. Patent No. 7,001,397 in view of Zucherman et al. (US 6,074,390).

Patented claims 3, 9, 17 and 25 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 16 of U.S. Patent No. 7,108,705 in view of Zucherman et al. (US 6,074,390).

Patented claims 6 and 16 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman et al. (US 6,074,390).

Zucherman et al. disclose a method of treating adjacent vertebrae in a spine of a patient including the steps of: inserting an access device or cannula through a minimally

invasive incision in the skin of a patient; expanding the access device by placing a plurality of cannula wherein the first smaller cannula is followed by a successively larger cannula; inserting an implant made of an elastic material through the largest cannula; and utilizing fasteners to fasten the implant to the adjacent vertebrae (Figs. 39 and 40, col. 1, lines 26-49, col. 4, lines 18-28, col. 9, lines 13-67 and col. 10, lines 1-14).

Regarding claims 30 and 36, Zucherman et al. disclose an implant in the form of a spring (Fig. 59 and col. 12, lines 23-31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (US 6,074,390) in view of Davison et al. (US 6,187,000).

Zucherman et al. disclose all elements of Applicant's claimed invention except for a single access device or cannula having an expandable distal end.

Davison et al. teach the use of a cannula having an expandable distal end enabling an increase in the cross-sectional area of the distal end of the cannula.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted a single cannula with an expandable distal end for multiple cannulae of increasingly larger diameters to obtain the predictable result of increasing the cross-sectional area of the distal end of the access passage into the body.

***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on December 26, 2007 have been fully considered but are not persuasive for the following reasons.

Contrary to Applicant's arguments, expanding the access device from a first configuration to a second configuration, does not preclude the use of additional devices placed over the access device, followed by removal of the access device resulting in an enlarged cross section. The Examiner reiterates that Zucherman et al. teach a method of expanding an access device by placement of additional access devices or cannulae of increasingly larger diameters, to expand the first cannula or access device from a first configuration or "arrangement" or "form" to a second "configuration" or "arrangement" or "form."

The Examiner notes that Applicant is not claiming that the distal end of the access device is being expanded from a first configuration to a second configuration, wherein the distal end of the access device in the second configuration has a larger cross sectional area than in the first configuration.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
January 7, 2008

  
ANURADHA RAMANA  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700